

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Edward R. Rowe et al.	Art Unit :	2193
Patent No. :	7,620,948	Examiner :	John Chavis
Issue Date :	November 17, 2009	Conf. No. :	9204
Serial No. :	10/651,697		
Filed :	August 29, 2003		
Title :	CLIENT SIDE SOFTWARE UPDATING		

Commissioner for Patents  
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**APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)**

Patentees hereby request reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 570 days to 910 days is respectfully requested.

**REMARKS**

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § 154(b)(2)(A). As outlined in Wyeth v. Kappos, No. 2009-1120 (Fed. Cir. Jan. 7, 2010), the only way that these periods of time can “overlap” is if they occur on the same day. If an “A delay” occurs on one calendar day and a “B delay” occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. Id.

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the application was delayed under 35 U.S.C. § 154(b)(1)(B) *before* the initial three-year period expired. The Wyeth v. Kappos court determined that this construction cannot be squared with the language of 35 U.S.C. § 154(b)(1)(B), which applies “if the issue of an original patent is delayed due to the

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failure of the United States Patent and Trademark Office to issue a patent within 3 years.”

“B delay” begins only after the PTO has failed to issue a patent within three years, not before.

Id.

#### REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

##### “A Delay”

A first PTO action was due on or before October 29, 2004 (the date that is fourteen months after August 29, 2003, the date on which the application was filed). The PTO mailed the first non-final Office Action on January 3, 2007, thereby according a PTO Delay of 796 days. Patentees do not dispute the PTO's calculation for this “A Delay” from October 30, 2004 (the day after the date that is fourteen months after the date on which the application was filed), to January 3, 2007. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

Patent issuance was due on or before October 23, 2009 (the date that is four months after June 23, 2009, the date on which the issue fee was paid). The PTO issued a patent on November 17, 2009, thereby according a PTO Delay of 25 days. Patentees do not dispute the PTO's calculation for this “A Delay” from October 24, 2009 (the day after the date that is four months after the date on which the issue fee was paid), to November 17, 2009. See 37 C.F.R. §§ 1.702(a)(4) and 1.703(a)(6).

In view of the periods of “A Delay” detailed above, the total “A Delay” for this patent should be calculated as 821 days (i.e., the sum of 796 days and 25 days).

##### “B Delay”

The period beginning on August 30, 2006 (the day after the date that is three years after August 29, 2003, the date on which the application was filed), and ending November 17, 2009 (the date the patent was issued), is 1,176 days in length.

“B Delay” may not include the number of days in the period beginning on the date on which a Request for Continued Examination was filed and ending on the date the patent was issued. See 37 C.F.R. §§ 1.702(b)(1) and 1.703(b)(1). In the present application, a Request for Continued Examination was filed on December 10, 2007, and the patent issued on

November 17, 2009, resulting in a period of 709 days that must be excluded from the three year delay calculation.

In addition, "B Delay" may not include the number of days in the period beginning on the date on which a Notice of Appeal was filed and ending on the date of mailing of a Notice of Allowance. See 37 C.F.R. §§ 1.702(b)(4) and 1.703(b)(4). In the present application, no Notice of Appeal was filed.

In view of the periods of "B Delay" detailed above, the total "B Delay" for this patent should be calculated as 467 days (i.e., 1,176 days minus 709 days). The PTO calculated 0 days of delay for issuance of a patent more than three years after filing. Patentees respectfully submit that the PTO's calculation of this "B Delay" is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 467 days. See 37 C.F.R. §§ 1.702(b) and 1.703(b).

#### Overlap of "A Delay" and "B Delay"

As detailed above, "A Delay" accumulated during the following periods:

October 30, 2004, to January 3, 2007; and

October 24, 2009, to November 17, 2009.

As detailed above, "B Delay" accumulated during the following period:

August 30, 2006, to December 10, 2007.

As such, the periods of "A Delay" and "B Delay" overlap (i.e., occur on the same calendar day) for a total of 127 days, from August 30, 2006 to January 3, 2007.

#### Applicant Delay

A reply to an Office Action was due on or before September 18, 2007 (the date that is three months after June 18, 2007, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on December 10, 2007, thereby according an Applicant Delay of 83 days. Patentees do not dispute the PTO's calculation for this Applicant Delay from September 19, 2007 (the day after the date that is three months after the date on which the Office Action was mailed), to December 10, 2007. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before October 24, 2008 (the date that is three months after July 24, 2008, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on December 22, 2008, thereby according an Applicant Delay of 59 days. Patentees do not dispute the PTO's calculation for this Applicant Delay from October 25, 2008 (the day after the date that is three months after the date on which the Office Action was mailed), to December 22, 2008. See 37 C.F.R. § 1.704(b).

Patentees filed an Amendment Pursuant to 37 C.F.R. § 1.312 on June 23, 2009, subsequent to the mailing of the Notice of Allowance. A Response to Rule 312 Communication was mailed on October 9, 2009. Patentees were accorded a delay of 109 days for this post-allowance filing. Patentees do not dispute the PTO's calculation for this Applicant Delay from June 23, 2009 to October 9, 2009. See 37 C.F.R. § 1.704(c)(10).

In view of the periods of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 251 days (i.e., the sum of 83 days, 59 days, and 109 days).

#### Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

#### Conclusion

In consideration of the events described above, Patentees believe the PTA calculation of 570 days is incorrect. As such, Patentees respectfully request reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 1,161 days (i.e., the sum of 821 days of "A Delay" and 467 days of "B Delay" minus 127 days overlapping delay);
- 2) Total Applicant Delay should be calculated as 251 days (i.e., the sum of 83 days, 59 days, and 109 days); and
- 3) Total PTA should be calculated as 910 days.

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The fee of \$200 required under 37 C.F.R. § 1.18(e) is being submitted herewith. Please apply any other required charges or credits to Deposit Account No. 06-1050, referencing attorney docket number 07844-0592001.

Respectfully submitted,

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